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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,169	12/17/2001	Hongzhuan Ye	25241.0004	6368
23517	7590	06/14/2006	EXAMINER	
BINGHAM MCCUTCHEN LLP			ABEL JALIL, NEVEEN	
3000 K STREET, NW			ART UNIT	
BOX IP			PAPER NUMBER	
WASHINGTON, DC 20007			2165	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/024,169

Applicant(s)

YE, HONGZHUAN

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-10 and 12-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, & 12-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Remarks*

1. In response to Amendment filed on March-23-2006, claims 5, and 11 have been cancelled. Therefore, claims 1-4, 6-10, and 12-27 are presently pending in the application.
2. Applicant's amendment has overcome the previously presented 112, second paragraph rejection.

### *Claim Objections*

3. Claims 1, and 3 are objected to because of the following informalities:

Claims 1, and 3 have the intended use recitation of "for" (i.e. database **for** storing) making the functionality following not carry any patentable weight since it never actually have to take place. Claims should be amended to recite more direct and positive language such as "is" or "storing" or "that". Correction is required.

Claims 1, 6, 8, and 14 recite the limitation "module operable to" is indirect, suggest optionally, and passive which renders any recitation claimed after not be given patentable weight. Appropriate correction is required.

The Examiner points to MPEP 2106 [R-2] wherein the claim's recitation of "operable to" raises the question to Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Office personnel must rely on the applicant's disclosure to properly determine the meaning of \*\* the claims. Limitations appearing in the specification but not recited in the claim are not read into the claim; therefore, in this case, the recitation of "operable to" as interpreted in light of the specification provide the "functionality" or "the capability" of the database management system to perform the steps without definite disclosure limiting or excluding any alternative, negative, or even all together suggest actually performing or implementing the functionality that is database management system is capable of.

Therefore, any cited art that teaches the steps otherwise in the alternative can be used to reject the instant application. The computer being operable to perform a function does not mean that it will ever actually perform that functionality ("operable to" should be clarified and changed to a more definite term i.e. "configured to" or "is" or "that").

Claims 16, and 22's preamble is intended use that never materializes. No nexus between the preamble and the body of the claim since the "for management" is never achieved in the claims therefore the claim never realizing its intended use it was set up to accomplish.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 9-10, 12, 20, 22, and 24-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 7, claim 16, line 6, and claim 20, line 2, and claim 22, line 8, all, recite the limitation "the contents". There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the processing" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claims 9, line 2, claim 10, line 2, claim 24, line 2, and claim 25, line 2, all recite the limitation "the number". There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "said predefined pattern" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 12, line 3, recites "it" which is an indefinite and vague recitation since its unclear what is being referenced by "it"?

Claim 22, line 5, recite "receiving approval" without any indication why an approval is required? What constitute an approval? Who gives the approval? Done by whom? Leaving it to be for vague and indefinite term for the Examiner to decipher and comprehend its relationship to the remaining claimed limitaion.

Claim 22 appears to be directed to transcribed documents throughout its recitations except for limitation 3 dealing with “creating an index for transcribed document” that precedes to recite “each index for a document” making it unclear if this is a new document being introduced that is not a transcribed one? Or is a different instance of the original transcribed document? Therefore lacks antecedent basis. Clarification is required.

9. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Applicant’s language of “enabling” (line 7, claim 16) a computer to do something, is not prohibiting and does not cause any functionality to occur in the computer and thus failing to particularly point out and distinctly claim their invention (it’s unclear what Applicant’s intended metes and bounds of the claim are, since the claim appears to cover anything and everything that does not prohibit actions from occurring). The recitation should either be deleted (simply recite “searching”) or amended to recite positive direct language (i.e. “configured to”).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-4, 6-8, 12-23, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over French (U.S. Patent No. 5,437,024) in view of Lo et al. (U.S. Patent No. 6,523,040 B1).

As to claim 1, French discloses a transcription management system, comprising:

- a central file system for storing a plurality of documents, each of said plurality of documents being stored in only one of at least two folders in said central file system based at least in part on a respective status of said plurality of documents (See French column 23, lines 1-25, teaches many variant folders “classes” that are ordered and stored as part of this centralized system that can include one or more databases for managing and storing those folders); and
- a content indexing module operable to create an index of said plurality of documents stored in said central file system (See French Figure 1, shows plurality of indexes for stored transcribed documents that includes “Lab reports, radiology etc.”, also see French column 19, lines 54-66);
- a document management module operable to manage the processing and distribution of said plurality of documents stored in said central file system in response to, at least in part, the respective status of said plurality of documents (See French column 13, lines 35-50, also see French column 14, lines 50-58); and
- a document distribution module operable at least one of said plurality of documents to at least one of a plurality of determined recipients based at least in part on a preference of said at least one of said plurality of recipients stored in a database (See French abstract, also see French column 9, lines 20-31).

French teaches the claimed invention expect for wherein an index for a document in the index of the plurality of documents is at least a value associated with a predefined ascii pattern in the contents of the document. French does not explicitly teach index value associated with a predefined ascii pattern in the contents of the document; however, he teaches these fields or indicia comprise strings of ascii characters embedded in a predetermined data communications format (See French column 13, lines 40-50).

Lo et al. teaches wherein an index for a document in the index of the plurality of documents is at least a value associated with a predefined ascii pattern in the contents of the document (See Lo et al. column 11, lines 17-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified French by the teaching of Lo et al. to include having an index for a document in the index of the plurality of documents is at least a value associated with a predefined ascii pattern in the contents of the document because it provides for efficient storage and retrieval

As to claim 2, French as modified discloses wherein each of a selected plurality of said plurality of documents comprises a transcribed document (See French column 11, lines 51-55).

As to claim 3, French as modified discloses database for storing information regarding a plurality of recipients (See French abstract).

As to claim 4, Ludwig et al. discloses wherein at least one of said plurality of recipients



is a physician (See French Figure 1, 16C).

As to claim 6, French as modified discloses wherein said document distribution module is further operable to recommend to a user a preferred method of distributing said at least one of said plurality of documents to said at least one of said plurality of recipients (See French column 13, lines 66-67, and see column 14, lines 1-7).

As to claim 7, French as modified discloses wherein said recommendation is based at least in part on information about said at least one of said plurality of recipients stored in said database (See French column 13, lines 66-67, and see French column 14, lines 1-7).

As to claims 8, and 23, French as modified discloses a billing module operable to generate an invoice for at least one of said plurality of documents (See French column 2, lines 1-5, prior art, also see French column 2, lines 21-26, prior art).

As to claim 12, French as modified discloses wherein said predefined pattern comprises a plurality of indexing fields, at least one of said plurality of indexing fields having the value associated with it (See French Figure 1, shows plurality of fields with values, also see French column 13, lines 54-65).

As to claim 14, French as modified discloses wherein said document management module is further operable to search a folder of said at least two folders for documents matching

a user specified criteria (See French column 12, lines 40-50, also see French column 14, lines 19-27, wherein “folders” reads on variant “classes/sub-classes” and wherein “user specified criteria” reads on “profile”).

As to claim 15, French as modified discloses wherein at least one of said plurality of documents comprises a transcribed radiology report (See French column 11, lines 45-57).

As to claim 16, French discloses a computer implemented method for management of transcribed documents, comprising:

storing a plurality of transcribed documents in a folder of a plurality of folders of a plurality of folders of a central file system (See French column 23, lines 1-25, teaches many variant folders “classes” that are ordered and stored as part of this centralized system that can include one or more databases for managing and storing those folders, also see French column 11, lines 51-55);

creating a plurality of indexes indexing said plurality of transcribed documents (See French Figure 1, shows plurality of indexes for stored transcribed documents that includes “Lab reports, radiology etc.”, also see French column 19, lines 54-66);

enabling searching of said plurality of transcribed documents based on said plurality of indexes (See French column 4, lines 29-43); and

automatically recommending to a user a preferred method of distributing a transcribed document of said plurality of documents to a recipient based at least in part on a preference of said recipient (See French column 13, lines 19-28, wherein “recommending” is actually the

directing performed by the controller based on the previously stored user preferences on how they like to receive the reports).

French teaches the claimed invention expect for wherein an index for a document in the index of the plurality of documents is at least a value associated with a predefined ascii pattern in the contents of the document. French does not explicitly teach index value associated with a predefined ascii pattern in the contents of the document; however, he teaches these fields or indicia comprise strings of ascii characters embedded in a predetermined data communications format (See French column 13, lines 40-50).

Lo et al. teaches wherein each index in said plurality of indexes is at least a value associated with a predefined ascii pattern comprising at least one indexing field in the contents of the document (See Lo et al. column 11, lines 17-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified French by the teaching of Lo et al. to include having an index for a document in the index of the plurality of documents is at least a value associated with a predefined ascii pattern in the contents of the document because it provides for efficient storage and retrieval

As to claim 17, French as modified discloses determining the name of said recipient (See French column 20, lines 1-15, also see French column 20, lines 31-40).

As to claims 18, and 27, French as modified discloses wherein said recipient is a physician (See French column 24, lines 46-52).

As to claim 19, French as modified discloses correlating said name of said recipient with information about said recipient stored in a physician database (See French column 19, lines 46-51, also see French column 20, lines 7-18).

As to claim 20, French as modified discloses reading the contents of said transcribed document to find the predefined pattern in said transcribed document (See French column 11, lines 51-55, also see French column 16, lines 1-8, shows predefined ascii pattern match).

As to claim 21, French as modified discloses distributing said transcribed document to said recipient in response to receiving information from said user regarding a selected method of distribution (See French column 13, lines 66-67, and see French column 14, lines 1-7).

As to claim 22, French discloses a computer implemented method for management of transcribed documents:

storing a plurality of transcribed documents in a plurality of folders of a central file system (See French column 23, lines 1-25, teaches many variant folders “classes” that are ordered and stored as part of this centralized system that can include one or more databases for managing and storing those folders, also see French column 11, lines 51-55);

moving at least one of said plurality of transcribed documents to a folder in said central file system upon receiving approval for said at least one transcribed document (See French column 49-63, wherein “moving” reads on “archiving”, and wherein “approval” reads on

“confirmation”, also see French column 11, lines 51-57, and see French column 24, lines 53-5-62);

creating an index of the transcribed documents in the at least one of the first folder and second folder (See French Figure 1, shows plurality of indexes for stored transcribed documents that includes “Lab reports, radiology etc.”, also see French column 19, lines 54-66);

automatically recommending to a user a preferred method of distributing said at least one transcribed document to a recipient based at least in part on a preference of said recipient (See column 13, lines 19-28, wherein “recommending” is actually the directing preformed by the controller based on the previously stored user preferences on how they like to receive the reports); and

transmitting said at least one transcribed document to said recipient in response to receiving information from said user regarding a selected method of distribution (See French column 13, lines 66-67, and see French column 14, lines 1-7).

French teaches the claimed invention expect for wherein an index for a document in the index of the plurality of documents is at least a value associated with a predefined ascii pattern in the contents of the document. French does not explicitly teach index value associated with a predefined ascii pattern in the contents of the document; however, he teaches these fields or indicia comprise strings of ascii characters embedded in a predetermined data communications format (See French column 13, lines 40-50).

Lo et al. teaches wherein each index in said plurality of indexes is at least a value associated with a predefined ascii pattern comprising at least one indexing field in the contents of the document (See Lo et al. column 11, lines 17-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified French by the teaching of Lo et al. to include having an index for a document in the index of the plurality of documents is at least a value associated with a predefined ascii pattern in the contents of the document because it provides for efficient storage and retrieval

As to claim 26, French as modified discloses moving said at least one transcribed document to a third folder in said central file system after transmission of said at least one transcribed document to said recipient (See French column 24, lines 50-65, wherein “after transmission” indicates the storage of previously sent reports “prior reposts”).

12. Claims 9-10, and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over French (U.S. Patent No. 5,437,024) in view of Lo et al. (U.S. Patent No. 6,523,040 B1) with respect to claims 1-4, 6-8, 12-23, and 26-27 above, and further in view of Podhradsky (U.S. Patent No. 5,978,755 (“Podhradsky”).

As to claims 9, and 24:

The invention of French as modified discloses the claimed invention except for wherein said invoice is generated based at least in part on the number of words in said at least one of said plurality of documents and generating an invoice for said at least one transcribed document.

Podhradsky teaches that it is known to provide for wherein said invoice is generated based at least in part on the number of words in said at least one of said plurality of documents and generating an invoice for said at least one transcribed document.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide for wherein said invoice is generated based at least in part on the number of words in said at least one of said plurality of documents and generating an invoice for said at least one transcribed document as taught by Podhradsky, since Podhradsky states at column 14, lines 50-67 that such a modification would provides information about the number of words in a dictation, can be used, for example when a dictation is transcribed or when a dictation has been completed, to bill for example the author of the dictation, the amount of the bill being based on the number of transcribed words, i.e. the number of words comprised in a dictation.

As to claims 10, and 25:

The modified invention of French discloses the claimed invention except for wherein said invoice is generated based at least in part on the number of lines in said at least one of said plurality of documents. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide for wherein said invoice is generated based at least in part on the number of lines in said at least one of said plurality of documents since it was known in the art that that charging for a unit of transcription of a document including words and lines of a text would enable a calculation based on the amount of text that has to be translated.

***Response to Arguments***

13. Applicant's arguments with respect to claims 1-4, 6-10, and 12-27 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument on page 10 that the references (i.e. Podhradsky) fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the presented invention gets the number of words by reading through strings in a document, counts letters, words or lines from any electronic document, not restricted to the one transcribed from a digitized dictation) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Conclusion***


14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. For list of cited references see PTO-form 892.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Neeven Abel-Jalil  
June 11, 2006